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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/695,323	10/28/2003	Louis P. Steinhauser	5269-000004/CPB	4859

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EXAMINER

BASINGER, SHERMAN D

ART UNIT PAPER NUMBER

3617

DATE MAILED: 03/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/695,323	Applicant(s) STEINHAUSER, LOUIS P.	
	Examiner Sherman D. Basinger	Art Unit 3617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on March 8, 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Davis.

Davis discloses an outboard motor position responsive system comprising an ignition system including the ignition switch sensor 290, an outboard motor position sensor 220 in communication with the ignition system, a microprocessor 100 in communication with the outboard motor position sensor, an alarm 380 in communication with the microprocessor and an ignition disabling switch shown at the bottom of figure 1b.

Davis does not disclose:

wherein when an

operator attempts to start the ignition system when the

outboard motor is tilted up beyond a maximum safe tilt position, the alarm is activated by the microprocessor to warn the operator;

wherein when an

operator attempts to start the

ignition system when the

outboard motor is tilted up beyond a maximum safe tilt position, the ignition disabling

switch is activated by the microprocessor to prevent the operator from starting the ignition system; and

wherein when

an operator attempts to start the ignition system when the

outboard motor is tilted up beyond

a maximum safe tilt position, the tilt circuit is

activated by the microprocessor to automatically lower the outboard motor.

However because the microprocessor of Davis can easily be programmed to all of the above, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains to do so. Motivation to do so is to protect the outboard motor engine from damage and to protect the boat operator or a passenger from the outboard motor propeller.

Davis also does not disclose:

wherein when an operator attempts to start the

ignition system when the outboard motor is tilted

up beyond a maximum safe tilt position, the alarm is

activated by the outboard motor position sensor to warn the operator;

wherein when an operator attempts to start the ignition system when the

outboard motor is tilted up beyond a maximum safe tilt position, the ignition disabling

switch is activated by the outboard motor position sensor to prevent the operator

from starting the ignition system; and

wherein when an operator attempts to start the ignition system when the outboard motor is tilted up beyond a maximum safe tilt position, the tilt circuit is activated by the outboard motor position sensor to automatically lower the outboard motor.

However, because the microprocessor of Davis can be programmed to have the outboard motor position sensor do all of the above, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains to have it do so. Motivation, again, is to protect the outboard motor engine, the outboard motor propeller, the operator and any passenger.

Response to Arguments

3. The double patenting rejections set forth in paragraphs 5-8 of the office action mailed November 9, 2004 have been overcome by the filing of the terminal disclaimer on March 8, 2005.

4. In the response filed March 7, 2005, applicant argues under the subtitle "REJECTIONS UNDER 35 U.S.C. § 103" that claims 1-9 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Davis (U.S. Pat. No. 5,142,473). This rejection is respectfully traversed. Davis cannot render Claims 1-9 obvious because, as the Examiner conceded in the Outstanding Office Action, Davis does not teach the limitation that when an operator attempts to start the ignition system when the outboard motor is tilted up beyond a maximum safe tilt position, the alarm (Claims 1 and 2), the ignition disabling switch (Claims 3 and 4), or the tilt circuit (Claims 5 and 6) is activated

by the microprocessor to automatically lower the outboard motor. The mere disclosure of a microprocessor in a power boat in Davis does not suggest to a person of ordinary skill that the microprocessor should be or can be easily reprogrammed, as stated in the Office Action, to automatically lower the outboard motor when an operator attempts to start the ignition system when the outboard motor is tilted up beyond a maximum safe tilt position. Davis does not teach or disclose a system that warns or prevents an operator from starting the outboard engine when it is tilted beyond a maximum safe tilt position whatsoever. Rather, Davis teaches a system to achieve a more optimal trim position while the boat is underway for a smoother boat ride. As MPEP 2143 with the heading "Basic Requirements of a Prima Facie Case of Obviousness" admonishes, the motivation must be in the references themselves or in the knowledge generally available to one of ordinary skill in the art, not in Applicant's disclosure. Since the Outstanding Office Action attempts to prove such motivation by the mere assertion that "the motivation is to protect the outboard motor engine from damage and to protect the boat operator or a passenger from the outboard motor propeller," with no support from Davis or other references, the rejection is focused on hindsight and is improper. Accordingly, Applicant respectfully requests that the rejections of Claims 1-9 be withdrawn.

5. In rebuttal, applicant's attention is directed toward MPEP 2114. The last paragraph of each of claims 1-9 sets forth a function of the apparatus claimed. While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of the structure rather than function. Davis discloses all of the claimed structure of each

apparatus claim 1-9. In the last paragraph of each of claims 1-9, applicant defines the function of the apparatus. See *In re Schreiber*, 128 F.3d 1473, 44 USPQ 2d 1429.

6. A claim containing a recitation with respect to the manner in which a claimed apparatus is intended to be employed, which the last paragraph in claims 1-9 do, does not differentiate the claimed apparatus from a prior art apparatus if the prior art apparatus teaches all the structural limitations of the claims, which Davis does. See *Ex parte Masham*, 2 USPQ2d 1647.

7. In conclusion, Davis discloses all of the structure defined in apparatus claims 1-9. All that Davis does not disclose is the function of the apparatus as defined in claims 1-9. As pointed out above, apparatus claims must be structurally different from the prior art.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sherman D. Basinger whose telephone number is 703-308-1139. The examiner can normally be reached on M-F (6:00-2:30 ET)/5:30-2:00(after 4/11/05).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Samuel J. Morano can be reached on 703-308-0230. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Sherman D. Basinger
Primary Examiner
Art Unit 3617
3/23/05

3/23/05